

IN THE DRAWINGS:

The Applicants respectfully present herewith replacement Figures 7 and 8, which include desired changes, without markings, and which comply with §1.84. The changes made to Figures 7 and 8 are explained in the accompanying remarks section below.

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

By the foregoing amendments, claims 2 and 4, and Figures 7 and 8, have been amended. Support for the amendments may be found, for example, on pages 7-8 of the specification. No new matter has been added. Thus, claims 1-9 are pending in this application and subject to examination.

In the Office Action mailed April 3, 2006, claim 4 was objected to for informalities. Claim 2 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In addition, claim 2 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1 and 3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hirasawa et al. (U.S. Patent Publication No. 2002/0020906, hereinafter "Hirasawa"). Claims 5 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirasawa. Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirasawa as applied to claim 5, and in view of Nishimura (U.S. Patent Publication No. 2003/0121437). Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirasawa as applied to claim 5, and in view of Wyland et al. (U.S. Patent No. 5,679,975, hereinafter "Wyland"). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirasawa as applied to claim 5, and in view of Worley et al. (U.S. Patent No. 6,885,016, hereinafter "Worley"). It is noted that claims 2 and 4 have been amended. To the extent these rejections remain applicable to the claims currently pending, the Applicants hereby traverse the rejections, as follows.

Replacement Figures 7 and 8

The Applicants respectfully submit that in Figures 7 and 8 of the drawings, the element designating the lower part of fitting frame 8 used for connection to the ground potential marked GND was incorrectly labeled as 12, and should have been labeled --L2--. Similarly, the lower part of signal output frame 12 was inaccurately labeled as 14, and should have been labeled --L4--. Applicants respectfully present replacement Figures 7 and 8 with the above corrections and request approval of the drawing changes.

Formal Matters

Claim 4 was objected to for informalities. Specifically, claim 4 was objected to because the language "one of" was not deleted. Claim 4 has now been amended responsive to the objection. The Applicants respectfully request withdrawal of the objection.

Claim 2 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In addition, claim 2 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 2 has now been amended responsive to the rejections. Specifically, claim 2 has been amended to recite "tie bars," which are described, for example on pages 7-8 of the specification. Accordingly, the Applicants respectfully request withdrawal of the rejections of claim 2 under 35 U.S.C. § 112, first and second paragraphs.

Claims 1 and 5 Recite Patentable Subject Matter

Regarding claims 1 and 5, the Applicants respectfully submit that nothing in the

cited art, taken alone or in combination, discloses or suggests at least the feature of of "a shielding frame that is tied via a tying portion to the fitting frame and that can be brought into such as state as to cover the element mount frame," as recited in claims 1 and 5. (Emphasis supplied)

Hirasawa is directed to a lead frame including a plurality of tie bars, each having deformable portions that protect opposite outside frames from deformation. The outside frames each are formed with positioning holes. Element loading portions to be loaded with semiconductor elements are connected to the outside frames by such tie bars. As shown in FIGs. 4A, 4B and 4C of Hirasawa, separately manufactured lead frames 10a and 10b are superimposed over each other to form frame 10c. Further, frame 10c is formed by "welding or otherwise connecting . . . [lead frames 10a and 10b] together. See Hirasawa, page 3, paragraph 0036.

The Office Action indicates element 14 of FIG. 5 of Hirasawa, as allegedly showing the claimed "tying portion." However, element 14 designates lead forming portions of each of separate lead frames 10a and 10b, as shown in FIGs. 4A and 4B, which are subsequently superimposed over each other and sealed in resin 20 (e.g., as shown in FIGs. 5C, 5D and 5E) without being connected to each other, and are not "tied via a tying portion," as claimed in claims 1 and 5.

For at least these reasons, the Applicants respectfully submit that claims 1 and 5 are allowable over the cited art.

Claims 2-4 and 6-9 Recite Patentable Subject Matter

Regarding claims 2-4 and 6-9, the Applicants respectfully submit that each of these claims depends from one of allowable claims 1 and 5, and is therefore allowable

for at least the same reasons.

Claim Rejections Under 35 U.S.C. § 103

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *Id.* In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

The Office Action restates the advantages of the present invention to justify the combination of references. See Office Action, at page 4. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure. Thus, the Applicants submit that a *prima facie* case of obviousness has not been established.

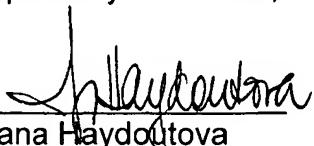
Conclusion

For all of the above reasons, it is respectfully submitted that the claims now pending recite patentable subject matter. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referring to client-matter number 103213-00105.

Respectfully submitted,



Juliana Haydoutova
Registration No. 43,313

Customer No. 004372

AREN'T FOX PLLC

1050 Connecticut Avenue, N.W., Suite 400
Washington, D.C. 20036-5339

Tel: (202) 715-8469

Fax: (202) 638-4810

JH:ksm

Enclosures: Replacement Figures 7 and 8